

REMARKS

Before addressing the §102 rejection of the pending claims and the amendment thereof in the present response, Applicant wishes to address the status of the present rejection as final. Applicant strongly objects to the present application being made final because original claim 9 was not amended in the previous Office Action and therefore, the grounds upon which the present §102 rejection were made have been pending since the application was originally filed. The Examiner states that Applicant's previous amendment necessitated the new grounds for rejection. In light of original claim 9, this is not true. Claim 9 was unamended in response to the previous Office Action. As such a new ground for rejection was not necessitated and the present application should not under final rejection. Therefore, it is respectfully requested that the classification of the present Office Action as final be withdrawn.

The present application stands rejected under §102 in view of U.S. Patent 5,997,562. The presently pending independent claims 1, 5, and 9 have each been amended to specifically overcome the rejection in view of the '562 patent.

Specifically, independent claims 1, 5, and 9 have been amended to specifically refer to the needle and surgical instrument as a phacoemulsification needle and a phacoemulsification surgical instrument. This distinction clearly removes any anticipation rejection of the present invention in view of the '562 patent. The '562 patent is directed to a wire introducer and balloon catheter sheath, which is essentially

completely unlike the intended use of the phacoemulsification needle claimed in the present application. The phacoemulsification needle as claimed in the present application is for use of extracting or aspirating cataract tissue from a patient's eye, not to introduce a foreign body into a human as the '562 patent teaches.

As has been recognized by the Courts, a functional limitation, such as characterizing a needle as a phacoemulsification needle, can be used to distinguish and patent an invention over the prior art. As stated by the C.C.P.A.:

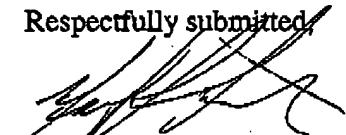
We take the characterization "functional" as used by the Patent Office and argued by the parties, to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what it *does* rather than by what it *is* (as evidenced by specific structure or material, for example). In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical *necessity* for the use of functional language."

In Re. Swinehart, 439 F2d 210169 U.S.P.Q. 226, 228- 229 (C.C.P.A. 1971).

The present amendment is directly responsive to the above quote, in that the addition of the word phacoemulsification to modify the words needle and surgical instrument defines the invention in terms of what it does in addition to what it is. Therefore, the present amended claims are distinguished over the '562 patent.

Therefore, it is respectfully submitted that the presently pending claims 1 - 2, 5 - 6, and 9 - 10 are allowable over the cited art, and such an allowance is requested at an early date.

Respectfully submitted,



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